

REMARKS**Summary of the Office Action**

Claim 1-7 stand rejected under U.S.C. §103(a) as being unpatentable over Curry (US 5,710,636) in view of Huttenlocher et al. (US 5,884,014).

The information disclosure statement filed on July 31, 2000 was not considered for allegedly not complying with 37 CFR 1.98(a)(3).

The specification is objected to as failing to comply with 37 CFR 1.84(p)(5).

Summary of Response to the Office Action

Applicant has amended independent claims 1 and 7 to further define the invention. Accordingly, claims 1-7 are presently pending.

Applicant respectfully submits concurrently herewith a Supplemental IDS to include English-language translations of the abstracts for each of the three foreign references originally cited in the IDS filed on July 31, 2000.

Information Disclosure Statement Filed on July 31, 2000

The Office Action alleges that the Information Disclosure Statement (IDS) filed on July 31, 2000 fails to comply with 37 CFR 1.98(a)(3). Specifically, the Office Action alleges that the IDS did not include a concise explanation of the relevance if each patent listed that is not in the English language. Applicant respectfully disagrees.

In the IDS filed on July 31, 2000, Applicant submitted statements for each of the references cited in the IDS. Specifically, on page 2 of the IDS, Applicant made concise relevancy statements with regard to each of the three Japanese-language references, and where in the specification the relevancy was discussed. However, in order to expedite consideration of the references cite in the IDS, Applicant submits concurrently herewith a Supplemental IDS that

includes English-language translations of the three Japanese-language references. Thus, Applicant respectfully assert that the Supplemental IDS complies with the requirements of 37 CFR 1.98, and requests that the Examiner consider all the references cited in the Supplemental IDS by placing the Examiner's initials next to each of the cited references listed on the accompanying PTO-1449. In addition, Applicant respectfully requests that an initialed copy of the PTO-1449 be returned with the next Office communication.

Drawings Objections

The drawings are objected to for failing to comply with 37 CFR 1.84(p)(5). Specifically, the Office Action alleges that item "S305" shown in FIG. 16 is not mentioned in the description. Accordingly, Applicant has amended the specification to make reference to item "S305" shown in FIG. 16. Thus, Applicant respectfully submits that the drawings comply with the requirements of 37 CFR 1.84(p)(5), and respectfully requests that the objection under 37 CFR 1.84(p)(5), be withdrawn.

All Claims Define Allowable Subject Matter

Claim 1-7 stand rejected under U.S.C. §103(a) as being unpatentable over Curry (US 5,710,636) in view of Huttenlocher et al. (US 5,884,014). Applicant respectfully traverses the rejections on grounds that it fails to set forth a *prima facie* case of obviousness.

Independent claim 1, as amended, recites an image processing apparatus including, at least, "an input part that inputs hyperdocument data" and "information to be superimposed over at least part of the image element to form the document image of the hyperdocument data inputted by the input part." Similarly, independent claim 7, as amended, recites an image forming medium including "coupling information from hyperdocument data for specifying related information related to the image element." Applicant respectfully submits that these

features of independent claims 1 and 7 are neither taught nor suggested by Curry and Huttenlocher et al., whether taken singly or combined.

The Office Action admits that “Curry does not disclose expressly that said bitmap data is information for specifying related information related to an image element constituting said document image.” Furthermore, the Office Action admits that “Curry does not disclose expressly that said coupling information is superimposed over an element of image.” Thus, Office Action relies upon Huttenlocher et al. for teaching embedding data that point to an object that also contains data, such as a spread sheet, a web page, or other such embedded objects, and that the objects are related to what is displayed at the portion of the page. As a result, the Office Action alleges that “it would have been obvious to a person of ordinary skill in the art to embed bitmap data in the image as taught by Curry; and embed said bitmap data, which points to an object that also contains data, over a specific portion of the image to which said object relates, as taught by Huttenlocher et al..” The Office Action alleged motivation for doing so “would have been to make a second set of digital information addressable and available for further use, such as distribution, transmission, storage, and internet document display.” Applicant respectfully disagrees.

Applicant respectfully asserts that the Office Action’s alleged motivation to modify Curry (i.e. to embed bitmap data in the image) is neither taught nor suggested by Huttenlocher et al. with respect to hyperdocument data. That is, embedding bitmap data in the image has no relationship with respect to embedding bitmap data that points to an object that also contains hyperdocument data over a specific portion of the image to the said object relates. Instead, Huttenlocher et al. teaches (column 4, Summary of Invention), “a document containing text and graphics is compiled from its original structured representation into a token-based representation,

and the token-based representation, in turn, is to produce a rendered pixel image, wherein each extracted token includes pixel data representing a subimage of the particular image collection and at least one of the token subimages contains multiple pixels and occurs at more than one position in the image collection.”

Thus, Applicant respectfully asserts that Huttenlocher et al. is completely silent with regard to an image processing apparatus including, at least, “an input part that inputs hyperdocument data and coupling information for specifying related information related to an image element constituting a document image hyperdocument data,” as recited by amended independent claim 1, and an image forming medium “on which an image constituted by an image element is formed, wherein coupling information from hyperdocument data for specifying related information related to the image element is superimposed over at least part of the image element,” as recited by amended independent claim 7.

Applicants respectfully note that MPEP 2143.01 instructs that “[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention, where there is some teaching, suggestion or motivation to do so found in either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.” Thus, Applicant respectfully asserts that the Office Action has not provided proper motivation for one of ordinary skill in the art to modify the teachings of Curry with the teachings of Huttenlocher et al. to achieve the invention of independent claims 1 and 7, and hence dependent claims 2-6.

For the above reasons, Applicant respectfully asserts that the rejection under 35 U.S.C. § 103(a) should be withdrawn because Curry and Huttenlocher et al., whether taken individually or

in combination, neither teach nor suggest the novel combination of features clearly recited in independent claims 1 and 7, and hence dependent claims 2- 6.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests reconsideration of this application, withdrawal of all rejections, and the timely allowance of all pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicant's undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.R.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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